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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,462	02/28/2002	Tomohiro Koyata	7217/66559	1812
530 7590 01/06/2010 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER LE, NANCY LOAN T	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/085,462	Applicant(s) KOYATA ET AL.	
	Examiner NANCY T. LE	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-8,10,11,13,16,17 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-8,10,11,13,16,17 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 October 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgements

1. Applicant's Amendment filed on **15 September 2009** is acknowledged.
2. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants". Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
3. This paper is given Paper No. 20100104 by the Examiner. This Paper No. is for reference purposes only.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on *21 October 2009* is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

5. Claims *1, 3, 6-8, 10, 11, 13, 16, 17 and 29-33* are pending and have been examined.

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims *1, 3, 6-8, 10, 11, 13, 16, 17 and 29-33* are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. **5,893,910 (Martineau et al.**; hereinafter “Martineau”), and in view of **US 7,362,946 B1 (Kowald)**, and in view of **US 7,315,829 (Tagawa)**, and further in view of **US 6,499,106 B1 (Yaegashi et al.**; hereinafter “Yaegashi”).

8. **Martineau** discloses a digital signal processing method, apparatus, an information center, and a data delivery system, comprising:

9. receiving identification information and inquiry information from a terminal device over a communication line, said identification information identifying selected digital content data read from a storage medium at the terminal device that have undergone a predetermined low-bit rate coding process and that are subject to an inquiry received from a user at the terminal device, said inquiry information being generated by said terminal device based on said selected digital content data and including a selected content data frame into which a portion of the selected digital content data has been encoded;

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10. retrieving said selected digital content data subject to said inquiry from a digital data storage of said information center based on said identification information for identifying said selected digital content data;
11. generating reference inquiry information based on the retrieved selected digital content data, wherein the reference inquiry information includes a reference content data frame corresponding to the selected content data frame;
12. comparing the reference content data frame included in the generated reference inquiry information with the selected content data frame included in the received inquiry information, wherein a match between the encoded digital content data of the reference content data frame and the portion of the selected digital content data in the selected content data frame is an indication that the selected digital content data read from the storage medium at the terminal device are legitimately purchased data;
13. generating an inquiry result based on a result of the step of comparing, wherein the inquiry result indicates whether the selected digital content data read from the storage medium at the terminal device are legitimately purchased data;
14. transmitting the inquiry result to the terminal device over the communication line;
15. transmitting means for transmitting inquiry information to an information center over a communication line, said inquiry information being generated in association with encoded digital data which have been recorded on a storage medium;
16. receiving means for receiving a result of an inquiry conducted by said information center based on said inquiry information;

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17. discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium are legally purchased data;
18. controlling means which, when said discriminating means judges said encoded digital data to be legally purchased data, then executes a process to offer an additional service to said customer, wherein said additional service offered to said customer;
19. wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium with an algorithm of a predetermined version, into digital data having undergone encoding with an algorithm of a more advanced version, before replacing the unconverted digital data with the converted digital data on said storage medium;
20. wherein said additional service offered to said customer comprises furnishing said customer, free of charge, with a product related to a producing party who produced said digital data purchased legally by said customer from said information center;
21. inputting means for inputting identification information for identifying said encoded digital data which are subject to said inquiry; wherein said identification information input through said inputting means is transmitted to said information center over said communication line;
22. receiving means for receiving said inquiry information and said identification information transmitted from said digital signal processing apparatus; retrieving means for retrieving digital data subject to said inquiry from said received inquiry information, the retrieved digital data subject to the inquiry including the extracted particular frame of music data; reference inquiry information generating means for generating reference

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inquiry information corresponding to said retrieved digital data subject to the inquiry, the generated reference inquiry information including the stored frame of music data; comparing means for comparing the generated reference inquiry information and the retrieved digital data subject to the inquiry; inquiry result generating means for generating the result of the inquiry based on a result of the comparison by said comparing means; and transmitting means for transmitting the result of the inquiry to said digital processing apparatus;

23. controlling means for *executing*, in response to said discriminating means judging said encoded digital data to be legally purchased data, *a process to offer an additional service to said customer*;

24. wherein, **if** said discriminating means judges that said encoded digital data recorded on said storage medium are legally purchased data, then said charging means either charges nothing or a reduced amount to said customer for said additional service offered to said customer (The USPTO interprets claim limitations that contain “**if, may, might, can, when** and **could**” statement(s), as **optional** language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.),

25. (**Martineau**, at least **Abstract**, **C. 1 L. 5-11**, **C. 2 L. 14 – C. 16 L. 67**, **claims 1-15**).

26. **Martineau** does not expressly disclose:

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27. “wherein the reference content data frame has **a timing of a start of recording** of encoded digital content data of the reference content data frame;

28. wherein a match between **the timing of the start of recording** of the encoded digital content data **of the reference content data frame** and **a timing of the start of recording of the portion of the selected digital content data in the selected content data frame** is an indication that the selected digital content data read from the storage medium at the terminal device are legitimately purchased data”.

29. **Kowald**, however, teaches:

30. “wherein the reference content data frame has **a timing of a start of recording** of encoded digital content data of the reference content data frame;

31. wherein a match between **the timing of the start of recording** of the encoded digital content data **of the reference content data frame** and **a timing of the start of recording of the portion of the selected digital content data in the selected content data frame** is an indication that the selected digital content data read from the storage medium at the terminal device are legitimately purchased data”;

32. (see **Kowald**, at least **C 7 L 16 – C 8 L 51, claim 53**), to include start time of recording/reproducing of the encoded digital content data to serve for future verification, validation or auditing purposes.

33. Therefor, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the following features:

34. “wherein the reference content data frame has **a timing of a start of recording** of encoded digital content data of the reference content data frame;

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35. wherein a match between **the timing of the start of recording of the encoded digital content data of the reference content data frame and a timing of the start of recording of the portion of the selected digital content data in the selected content data frame** is an indication that the selected digital content data read from the storage medium at the terminal device are legitimately purchased data”,

36. as taught in the Kowald reference to the method and system of establishing the legitimacy of use of digital content as disclosed in the Martineau reference to include start time of recording/reproducing of the encoded digital content data to serve for future verification, validation or auditing purposes.

37. Neither Martineau nor Kowald, taken alone or in combination thereof teach or suggest that the controlling means also includes moving said encoded data from said storage medium to another storage medium; restoring said encoded digital data onto said storage medium if the encoded digital data has been partially destroyed; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate.

38. **Tagawa**, however, teaches controlling means that includes moving said encoded data from said storage medium to another storage medium; restoring said encoded digital data onto said storage medium; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate (see **Summary, C 1 L 1 – C 20 L23**).

39. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Martineau and Kowald references to include the mechanism of

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Tagawa to provide a recording/reproducing apparatus which is capable of accommodating plural usages having different demand levels while reducing the economic load without jeopardizing and lowering the dependability and quality to the customer, respectively.

40. None of the Martineau, Kowald, and Tagawa references, taken alone or in combination thereof teach or suggest such a digital signal processing apparatus, the apparatus further comprising:

41. *said transmitted inquiry information including **a particular frame** of music data **extracted from encoded digital data** that have been recorded on a storage medium;*

42. *the result of the transmitted inquiry indicating whether **the extracted particular frame** of music data matches **a corresponding frame** of music data stored in the information center, the **stored frame** of music data being encoded or recorded in a manner consistent with the digital signal processing apparatus, the **extracted particular frame** of music data matching **the stored frame** of music data **only when** the encoded digital data recorded on the storage medium was encoded or recorded in the manner consistent with the digital signal processing apparatus (The USPTO interprets claim limitations that contain “**if, may, might, can, when** and **could**” statement(s), as **optional** language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.);*

43. discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was **encoded or recorded**

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in the manner consistent with the digital signal processing apparatus and thus legally purchased data.

44. **Yaegashi**, however, teach a method and apparatus for securing distribution of information recorded on fixed media (i.e., claimed storage medium), the method further comprising:

45. *said transmitted inquiry information including **a particular frame** of music data **extracted from encoded digital data** that have been recorded on a storage medium* (**Yaegashi**, at least the **Abstract, C 8 L 60 – C 11 L 21**);

46. *the result of the transmitted inquiry indicating whether **the extracted particular frame** of music data matches a **corresponding frame** of music data stored in the information center, the **stored frame** of music data being **encoded** or **recorded in a manner consistent with the digital signal processing apparatus**, the **extracted particular frame** of music data matching **the stored frame** of music data **only when** the encoded digital data recorded on the storage medium was encoded or recorded in the manner consistent with the digital signal processing apparatus* (**Yaegashi**, at least the **Abstract, C 8 L 60 – C 11 L 21**);

47. *discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was **encoded or recorded in the manner consistent with the digital signal processing apparatus** and thus legally purchased data* (**Yaegashi**, at least the **Abstract, C 8 L 60 – C 11 L 21**),
to determine whether or not the encoded digital data recorded on the storage medium is legitimate, i.e., legally purchase.

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48. Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to add the following features:

49. “said transmitted inquiry information including **a particular frame** of music data **extracted from encoded digital data** that have been recorded on a storage medium;

50. the result of the transmitted inquiry indicating whether **the extracted particular frame** of music data matches **a corresponding frame** of music data stored in the information center, the **stored frame** of music data being encoded or recorded in a manner consistent with the digital signal processing apparatus, the **extracted particular frame** of music data matching **the stored frame** of music data **only when** the encoded digital data recorded on the storage medium was encoded or recorded in the manner consistent with the digital signal processing apparatus;

51. discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was **encoded or recorded in the manner consistent with the digital signal processing apparatus** and thus legally purchased data”,

52. to the combination of the Martineau, Kowald, Tagawa references to determine the legitimacy of an encoded digital data recorded on a storage medium, and based upon this determination, offer an additional service to the customer whose encoded digital data recorded on such a storage medium is determined to be legitimate, i.e., legally purchased.

53. As the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did

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separately, so, one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

54. Applicant's arguments, see Amendment, filed 09/15/2009, with respect to the rejection of claims *1, 3, 6-8, 10, 11, 13, 16, 17 and 29-33* under 35 USC 112, second paragraph, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made as discussed in the 103 rejection above.

Conclusion

55. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

56. US 7046607 (Yamada)

57. US 2001/0017828 (Yamada)

58. US 5345316 (Ozaki)

59. US 6076063 (Unno)

60. US 6711624 (Nakura)

61. US 7562300 (Tobia)

62. US 5592511 (Schoen)

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63. US 6463539 (Mochizuki)

64. US 5870467 (Imai)

65. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

66. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

67. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **NANCY LOAN T. LE** whose telephone number is **(571) 272-7066**. The examiner can normally be reached on **Monday - Friday, 9am - 6:00pm Eastern Standard Time**.

68. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **ANDREW J. FISCHER** can be reached on **(571) 272-6779**.

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69. For **official/regular communication**, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

70. For **informal/draft communication**, the fax number is **(571) 273-7066 (Rightfax)**.

71. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.

NANCY T. LE
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621